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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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JAY S. WALKER

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EXAMINER

KARMIS, STEFANOS

ART UNIT

PAPER NUMBER

3693

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/316,546	Applicant(s) WALKER ET AL.	
	Examiner STEFANOS KARMIS	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to the amendment filed on 08 August 2008.

Status of Claims

2. Claims 2, 6, 44 and 56 are currently amended. Claim 1 is currently cancelled. Therefore, claims 2-58 are under prosecution in this application.

Response to Arguments

3. Applicant's arguments with respect to claim 2-58 have been considered but are not persuasive.

4. Applicant argues first with respect claim 1. However, independent claim 1 has been cancelled and thus the arguments directed at claim 1 are technically moot. Nonetheless the Examiner will address the arguments since they are now applicable to claim 2. Applicant is arguing that Cole in view of Schreadley in further view of Wilson fails to teach *providing a benefit to a customer after receiving an acceptance*. Specifically, Applicant argues that Wilson cannot suggest indicating the amount of a calculated tip *after* receiving the acceptance and that Wilson is silent as to how the tip is calculated. The Examiner respectfully disagrees. Wilson clearly teaches that American Express developed a feature on its electronic card processor that will automatically calculate from the bill a gratuity selected by the restaurant. Therefore, the restaurant is determining the gratuity percentage amounts and American Express electronic card processor performs the calculation based on the authorization amount and the tip percentage

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specified by the restaurant (see page 1, paragraph about American Express). Further, Wilson states that the American Express system puts the suggested calculated tip on the receipt *after* the machine validates the card (see page 1, paragraph about American Express). Therefore, the benefit of a calculated tip amount presented to the customer in which the consumer merely s to check a box to leave the appropriate tip, is provided after the card is validated, and after the customer checks the box on the receipt.

Further, regarding claim 2, Applicant argues that Wilson fails to teach that the offer defines an obligation for the customer to exchange for the benefit. Applicant argues that the obligation and benefit are the same in Wilson, that of paying the tip, and that it would defy logic and common sense to suggest that any offer would requires its obligation to be the same as the benefit. The Examiner respectfully disagrees. Clearly anyone of ordinary skill in the art would recognize that the obligation and benefit are not the same. The obligation taught by Wilson is that the customer pay the tip amount after selecting the appropriate box. The benefit is that the customer does not have to calculate the tip, since the restaurant has provided guidance to American Express to print the tip options on the receipt and simply allow the customer to check a box. Therefore the customer would not have to perform a calculation or even accidentally leave a tip in error due to a miscalculation. Also, the Examiner notes that claim 3 defines obligation as an additional payment, which is what paying a tip is. Further, it is unclear to the Examiner, how Applicant's specification, Figure 14, which discloses an embodiment in which a calculated tip is printed on a receipt which allows the customer to check a box to pay the tip, somehow teaches an obligation for the customer to fulfill in exchange for the benefit, while the teachings of Wilson, which also teach a calculated tip printed on a receipt for the customer to

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check a box, would not. Furthermore, Applicant's own specification on page 6, lines 21-23, discusses surveys or questionnaires in which the customer is "obligated to, for example, write out an answer or fill in a checkbox." Therefore, it reasonably appears that Applicant considers checking a box to be an obligation. In which case, in the teachings of Wilson, which teach checking a box to leave a tip, could also be interpreted to be fulfilling an obligation (checking the box) to receive the benefit of leaving a pre-calculated tip. For the above reasons, Wilson teaches fulfilling an obligation in order to receive a benefit.

For these reasons, Applicant's arguments with respect to claim 2-5 are not persuasive and thus claim 2-5 remains rejected under Cole in view of Schreadley in further view of Wilson. Applicant has provided similar arguments for claims 6-50 and 56-58, therefore these arguments stand or fall with the arguments addressed above.

5. With respect to claim 51, Applicant argues that Cole in view of Schreadley in further view of Wilson in further view of Schultz fails to teach providing a product. The Examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Claim 51, in its broadest interpretation, registering an offer, and presenting the offer to a customer during a transaction with a merchant. Therefore, the product could be the subject of the transaction. It is not necessarily a supplemental offer. Schulze teaches offering incentives or advantages to particular consumers (column 7, lines 8-28). Schulze further teaches that the offers include discount coupons, bonus points or checks directly convertible to cash (column 7, lines 8-55). Items such as coupons and checks are considered products. Applicant's claim does not define product in such a way that would preclude a coupon

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or check being offered to the consumer, to not be a product. Therefore, given the broadest reasonable interpretation, Cole in view of Schreadley in further view of Wilson in further view of Schultz does teach presenting an offer to a customer during a transaction with a merchant in which the offer specifies a product. Therefore this argument is not persuasive.

6. Regarding claim 55, Applicant argues that the prior art fails to teach the recited feature of separate signature lines for the purchase amount and the offer. This argument is without merit. Claim 55 is dependent upon independent claim 51. Independent claim 51 does not contain a "purchase amount." Therefore, claim 55 only teaches one signature line. The prior art cited discloses the use of a signature line to accept offers and to provide authorization. Therefore this argument is not persuasive.

7. Lastly, Applicant has not provided arguments against the Official Notice rejection taken by the Examiner and thus the statement is taken to be admitted prior art because Applicant failed to traverse the Examiner's assertion of Official Notice.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 2, 6, 7, 44, 49, 56 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole U.S. Patent 5,850,217 in view of Schreadley Jr. U.S. Patent 5,887,903 (hereinafter Schreadley) in further view of Restaurants Offering Own Tips On How Much To Give Waiter (hereinafter Wilson).

Regarding independent claim 2, Cole teaches a method for providing an offer during a transaction between a merchant and a customer comprising: receiving a request for authorization of a purchase amount, the purchase amount to be paid from a financial account of the customer (column 5, line 46 thru column 7, line 2) and transmitting an authorization of the purchase amount through a signature (column 5, line 46 thru column 7, line 2). Cole further teaches printing graphical information on the receipt (Figure 7). Schreadley teaches a combined check and tipping guide in which a tipping guide is printed on the back of the check for the convenience of the customer (column 2, lines 1-57). Cole and Schreadley fail to teach providing an offer. Wilson teaches providing an offer that allows customers to check a box for the desired tip, thereby outputting on the record of charge an indication of acceptance (See Full Text). This provides a benefit to the customer in that the tip is paid without the customer having to perform the calculation. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to combine the teachings of Cole in view of Schreadley in further view of Wilson because it provides for putting graphical information on a receipt and allowing the customer to select a tip amount that is pre-calculated, thus making it easier for the customer to finalize their bill payment. This teaching is consistent with Figure 14 of the instant application.

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Wilson further teaches that the offer defines an obligation for the customer to fulfill in exchange for the benefit (See full text: Customer must pay more as an obligation).

Claims 6, 7, 44, 49, 56 and 57 are substantially similar to the claims addressed above and are therefore rejected under the same reasoning.

10. Claims 3-5, 8-43, 45-48, 50-55 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole U.S. Patent 5,850,217 in view of Schreadley Jr. U.S. Patent 5,887,903 (hereinafter Schreadley) in further view of Restaurants Offering Own Tips On How Much To Give Waiter (hereinafter Wilson) in further view of Schultz U.S. Patent 6,233,564.

Claims 3-5, 9, 10, 17-43, 45-48 and 51-55, Cole in view Schreadley in further view of Wilson teaches that the benefit is providing the tip. However they fail to teach that the benefit is a supplemental product or discount and survey. Schulze teaches filling out surveys related to food and other items and using identifying sources such as credit cards and receiving a discount or cash as a result (column 6, line 43 thru column 7, line 55). The survey information is communicated over a telecommunication line like when validated credit cards in restaurants (column 6, line 43 thru column 7, line 55). It would've been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Cole in view Schreadley in further view of Wilson to include the teachings of Schulze because it provides other benefits that a customer would be interested in. It also would have been obvious to

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substitute a discount or cash for a supplemental product as it is merely a substitution of an incentive.

Regarding claims 8, 11-16, 50 and 58, Official Notice is taken that available credit and accounts in good standing are old and well known in the financial arts for processing credit card payments. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of the prior art to include the checks during credit authorization because it is the type of information used in credit card authorization networks to ensure a customer should be allowed to complete the transaction.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEFANOS KARMIS whose telephone number is (571)272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted
/Stefanos Karmis/
Primary Examiner, Art Unit 3693
04 November 2008